

REMARKS

Claims 1 - 8 have been amended and claim 9 has been added.

Claims 1 - 9 are in the case.

REJECTIONS:

The title of the invention was deemed to be non-descriptive and a new title was required.

Claims 1 - 8 were rejected under 35 U.S.C. § 112, second paragraph, as being generally narrative and indefinite and containing many grammatical and idiomatic errors.

Claims 1 - 8 were also rejected under 35 U.S.C. § 102(e) as anticipated by the reference PEPE ET AL (US 5,742,905).

REPLY:

The title has been amended to better indicate the subject matter of the invention and reflect the language in the claims.

The claims have been extensively amended to remove the informal language therefrom and are now believed to be in proper statutory form.

Regarding the prior art rejection, Applicant would like first to point out that in the embodiments disclosed in the PEPE ET AL reference an e-mail message is retained in the server until it is actively retrieved therefrom. In other words, the e-mail message has to be retrieved from the server by the subscriber. For example, if the subscriber wants his e-mail messages to be addressed to another address, his e-mail address is changed, but the messages are not transmitted to his mobile phone, pager or PDA. Actually, the e-mail messages are transmitted to the e-mail server which processes the messages transmitted to an e-mail address of the receiver, and as noted above the subscriber has to retrieve his e-mail messages from the server himself.

In PEPE's teaching fax messages require a data call, and they cannot be utilized in connection with messages generated on the basis of calendar events. Furthermore, fax messages have a bitmap structure, and require a bitmap viewer. According to PEPE's teaching, a fax message is always transmitted to a server from

which it has to be separately retrieved after receiving a notification message of its receipt. In other words, the message does not actually arrive in the secondary phone without it being requested by the subscriber. Another consideration is the fact that PEPE mentions the transmission of notifications, which seems to suggest that the message in question has to be retrieved from somewhere so that the notification is merely of the presence of the message rather than the message per se, in contrast to Applicant's invention wherein the message itself is received without a further operation being required, other than an acknowledgement in an appropriate situation.

With respect to the Examiner's contention, regarding claim 3, that it is inherent that the messages in PEPE can be calendar based events, it should be understood that in Applicant's invention the messages are transmitted at a certain time, i.e., they are calendar based events to the extent that the moment of their generation for transmission is set up when the message is stored. However, it appears that the Examiner is referring in his contention to the fact that a message can contain information about calendar events, e.g., topics to be discussed, schedules, etc., which information does not affect the moment of transmission of the message. Therefore, the invention is distinguishable from the teaching of PEPE in this regard and it will be seen that the language of claims 3 and 7 now specifies that the message is "generated" on the basis of "the notification of" calendar events.

It is well recognized in the law that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", Ex Parte Gould, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval In re Marshall, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978). Anticipation requires that every element of the claimed invention be previously "described in a single reference." Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991).

In view of the differences cited between Applicant's invention, as now defined in the claims, and the teaching of PEPE, it is submitted that PEPE fails to anticipate claims 1 and 6, and their dependent claims, under 35 U.S.C. §102(e) so that their rejection on those grounds should be withdrawn.

Also, it is submitted that the PEPE reference contains no teaching

or suggestion of Applicant's invention as now claimed, that would in any other way negate its patentability.

In summary, Applicant has appropriately amended the claims to put them in proper statutory form and informalities in the Title and specification have been corrected by the requested amendments. Therefore, as the application is now in complete conformance with the requirements of the statutes and the claims are patentably distinguishable over the prior art, it is submitted that all of the claims are now in condition for allowance and the issuance of a Notice of Allowance and passage to issue of this application is earnestly solicited and respectfully requested.

Corrected formal drawings to replace the informal drawings filed with the application will be submitted upon allowance.

A two-month extension of time to respond to the above-cited Office Action is hereby petitioned and a check for \$380.00 to cover the fee therefor is enclosed.

No further fee is believed to be required for the entry of this amendment, but should one be necessary, it is authorized and requested that it be deducted from Deposit Account No. 16-1350, and the amendment be timely entered.

Respectfully submitted,

Thomas P. Dowd

Thomas P. Dowd, Reg. No. 24,586

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Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06430
Customer No.: 2512

Tel. (203) 259-1800
Fax. (203) 255-5170

CERTIFICATE OF MAILING

I hereby certify that the attached Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231.

Shannon Murphy

Name of Person Making Deposit

8/16/2000
Date